

### **Remarks**

Reconsideration of the application is respectfully requested in view of the following remarks. Upon entry of this response, claims 4-7, and 13-26 remain in the application. Claims 1-3 and 8-12 have previously been canceled without prejudice. Claims 22-26 are new.

### **Formal Request For Interview**

Upon reviewing this response, if any issues remain, the Examiner is formally requested to contact the undersigned prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicants submit the foregoing formal Response so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more focused. This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

### **Claim Rejections Under 35 USC § 103(a)**

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. [MPEP § 2142.]

### ***Claims Rejected Over a Proposed Herz-Connelly-Alexander Combination***

The Office asserts that claim 13 is unpatentable over Herz, U.S. Patent No. 5,758,257 (Herz) in view of Connelly, U.S. Patent No. 6,144,376 ("Connelly"), and further in view of Alexander, U.S. Patent No. 6,177,931 ("Alexander").

#### ***Claim 13.***

Applicants respectfully assert that Herz fails to teach or suggest, at least, the language of claim 13 "*wherein upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping.*"

The Action cites to the following passage of Herz to teach or suggest the above limitation:

Such a technique may also be used to monitor changing preferences and even changes

in demographics for the customers connected to each node by periodically updating the clustered customer profiles for that node to reflect the changes in the customer profiles of those customers connected to a particular node. [Herz, 48:36-47.]

Herz describes two hardware implementations of his system. The first, a “one way data transmission system” sends movies and other data to customers, but does not accept feedback from the customers. Information moves strictly from the system to the clients of the system. [Herz, Fig. 4; 40:33-42.] The second, a “two-way implementation,” not only sends data to customers, but also gathers information about the data so processed. [Herz, Fig. 5, 41:20-41.] This data is then used, at the head-end [Herz, 41:20-25; Fig. 5 at 502] to create profiles for individual customers based on their viewing habits. Information about many customers with similar attributes (such as a zip code) may then be used to create an initial customer profile for a new customer. [Herz, 48:5-22.]

The passage in Herz cited by the Action, above, describes a hybrid system in which some customers use a two-way set-top box that gathers information about customer behavior, and other customers have a one-way set-top box which does not gather any such information. Customer profiles developed for those with the two-way set-top box within a particular area (the “node”) are used to generate default customer profiles for those with one-way set top boxes within the same node, and to supply initial customer profiles for new customers in the same node about which nothing is yet known. The specific passage refers to “periodically updat[ing]” the “clustered customer profile” (the profile used as a default for one-way set-top box users within the cluster) as the customer profiles for the two-way set-top box customers (which modify over time using feedback passed from the box to the head-end) are themselves updated.

Claim 13 has the limitation “wherein upon returning to an interactive entertainment channel....” Even if, for argument’s sake, one equates the customer profiles with plural selections, the passage cited in Herz, above, does not teach or suggest that the customer profiles have any actions performed upon them “upon returning to an interactive entertainment channel.” Rather, the “clustered customer profile” is updated at the head-end, which teaches away from performing an action upon returning to an entertainment channel. [Herz, 41:67-42:7.] Moreover, “periodically updat[ing]” a customer profile does not teach or suggest the additional claim limitation “automatically cycl[ing] through plural selections” as further found in claim 13. Moreover, neither Connelly nor Alexander, either separately or in combination, teach or suggest the above claim language.

For at least these reasons, claim 13 is allowable. Such action is respectfully requested.

***Claims Rejected Over a Proposed Herz-Yoshinobu-Alexander Combination***

The Office asserts that claims 6, 4, 5, 20, and 21 are unpatentable over Herz, in view of Yoshinobu, U.S. Patent No. 5,734,444 (“Yoshinobu”) and further in view of Alexander.

*Claim 6.*

Applicants respectfully assert that Herz, Yoshinobu, and Alexander, either separately or in combination, fail to teach or suggest, at least, the language of claim 6 “*monitoring the user’s viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.*”

The Action indicates that “Herz fails to disclose monitoring the user’s viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.” [Action, p. 7.] Applicants agree. Applicants disagree, however, with the Action’s statement that Yoshinobu teaches or suggests the above claim language.

The Action cites to the following passages of Yoshinobu to teach or suggest the above limitation:

According to the present invention, as mentioned above, any frequent reception channel usually received and watched by a user is detected from a past reception history, and when the frequent reception channel thus detected is not being watched now, it is recorded automatically by a recording/playback unit, so that the user is enabled to watch later the favorite program on the frequent reception channel merely by reproducing the program in the recording/playback unit. [Yoshinobu, 24:51-59.]

In this embodiment, despite the existence of any program channel received frequently in the past, a priority is given to a reserved program when a video recording operation is being performed in a reserved recording mode or when the television receiver is placed in a reserved hour wait state by a video recording reservation. [Yoshinobu, 11:38-43.]

More specifically, the CPU 101 successively stores the start time and end time of the automatic video recording and also the channel data thereof in the SRAM 105. And when a recording history call button of the remote commander for example is

actuated by the user, the stored history data is retrieved and displayed on the screen, as shown in FIG. 10. Then the user selects desired one of the recorded contents from the displayed data in FIG. 10 by actuating an up/down cursor key of the remote commander and reproduces the desired program to enjoy the same.

In each of the embodiments mentioned above, any channel selected once is recorded directly as frequency 1. However, depending on the user's preference, frequency data may be weighted with respect to particularly favorite programs. For the purpose of weighting frequency data, a weighting button may be provided on the remote commander to enable the user to weight the channels which are to be received. [Yoshinobu, 14:48-65.]

Yoshinobu describes a system that determines that a channel at a certain time is a "frequent reception program" if it is viewed more often than a predetermined amount. [Yoshinobu, 2:49-56; 14:48-57.] Thus, Yoshinobu teaches placing certain programs into a single group—the "frequent reception program" group. Within the group, programs are not ranked. When a frequently-viewed program is being broadcast, and when no other program is being watched, the frequently viewed program will be automatically recorded. [Yoshinobu, 24:51-59.]

However, because there is only one variable used to determine if a program will be automatically recorded, the "predetermined amount," a viewer needs a way to signal to the Yoshinobu system when he or she wishes to have a program automatically recorded that has not been previously viewed. This is done by the user assigning a higher weight to certain channels or types of programs. Then, when a program on a weighted channel is viewed, the specific viewing will be given a greater weight; i.e., that specific viewing will count more towards that program reaching the predetermined amount necessary for the program to be considered a "frequent reception" program and therefore automatically recorded. [Yoshinobu, 14:66-15:6.] Thus, Yoshinobu teaches allowing the user to bend the rules for certain programs to allow them easier entry into the "frequent reception" category. The programs, however, are not ranked. Rather, they are instead divided into two groups; i.e., "do not record" and "automatically record." As Yoshinobu does not provide a ranking of video programs, Yoshinobu does not teach or suggest monitoring the user's viewing habits to *determine a ranking* of viewed broadcast video programs by viewing frequency.

In fact, as Yoshinobu provides a single value, the "predetermined amount," which determines if a program will be automatically recorded, this teaches away from *ranking* viewed programs by viewing frequency, as no rank can be determined from the single value.

It is true that Yoshinobu does allow a user's preset recording reservation to override an automatic "frequent reception" recording. [Yoshinobu, 11:38-43.] However, a user override of an automatic program recordation does not teach or suggest "*monitoring the user's viewing habits,*" as there is no monitoring done, rather the user controls when the override occurs. Thus, as Yoshinobu fails to teach or *suggest monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency*, Applicants respectfully submit that claim 6 is in condition for allowance.

As Yoshinobu teaches away from ranking, Yoshinobu also fails to teach or suggest *copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking*. As stated above, Yoshinobu does allow a user's preset recording reservation to override an automatic "frequent reception" recording. [Yoshinobu, 11:38-43.] However, such a user override has nothing to with any ranking of the programs, rather, the user makes a determination to copy a specific program with no hint in Yoshinobu that such a choice is based on a ranking. Therefore, for this separate reason, claim 6 is in condition for allowance.

#### *Claims 20 and 21.*

Claims 20 and 21 depend ultimately from claim 6. In the interest of brevity, Applicants do not belabor the language of each of the dependent claims, but point out that they recite novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander combination. Since they depend from an allowable claim, they should be allowed for at least the reasons stated for claim 6. In view of the foregoing discussion of claim 6, the merits of the separate patentability of dependent claims 20 and 21 are not belabored at this time. Claims 20 and 21 should be allowable. Such action is respectfully requested.

#### *Claims 4 and 5.*

Claims 4 and 5 depend ultimately from allowable claim 13. Since they depend from an allowable claim, they should be allowed for at least the reasons stated for claim 13. Applicants also point out these claim recites novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander combination. Claims 4 and 5 should be allowable. Such action is respectfully requested.

***Claims Rejected Over a Proposed Herz-Yoshinobu-Alexander-Lazarus Combination***

The Office asserts a rejection of claims 7 and 14-18 as obvious over Herz and Yoshinobu, in view of Alexander, and in further view of Lazarus, U.S. Patent No. 5,652,613 ("Lazarus").

***Claims 7 and 14.***

Applicants respectfully assert that Herz, Yoshinobu, Alexander, and Lazarus, either separately or in combination fail to teach or suggest, at least, the language of claim 7 *"monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking,"* and the language of claim 14 *"instructions for monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and instructions for copying to a storage medium plural programs that are not viewed by the user when broadcast, in accordance with said ranking."*

The Action indicates that "Herz fails to disclose monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking." [Action, p. 11.] Applicants agree. Applicants disagree, however, with the Action's statement that Yoshinobu teaches or suggests the above claim language.

The Action cites to the following passages of Yoshinobu to teach or suggest the above limitations:

According to the present invention, as mentioned above, any frequent reception channel usually received and watched by a user is detected from a past reception history, and when the frequent reception channel thus detected is not being watched now, it is recorded automatically by a recording/playback unit, so that the user is enabled to watch later the favorite program on the frequent reception channel merely by reproducing the program in the recording/playback unit. [Yoshinobu, 24:51-59.]

In this embodiment, despite the existence of any program channel received frequently in the past, a priority is given to a reserved program when a video recording operation is being performed in a reserved recording mode or when the television receiver is placed in a reserved hour wait state by a video recording reservation. [Yoshinobu, 11:38-43.]

More specifically, the CPU 101 successively stores the start time and end time of the automatic video recording and also the channel data thereof in the SRAM 105. And when a recording history call button of the remote commander for example is actuated by the user, the stored history data is retrieved and displayed on the screen, as shown in FIG. 10. Then the user selects desired one of the recorded contents from the displayed data in FIG. 10 by actuating an up/down cursor key of the remote commander and reproduces the desired program to enjoy the same.

In each of the embodiments mentioned above, any channel selected once is recorded directly as frequency 1. However, depending on the user's preference, frequency data may be weighted with respect to particularly favorite programs. For the purpose of weighting frequency data, a weighting button may be provided on the remote commander to enable the user to weight the channels which are to be received. [Yoshinobu, 14:48-65.]

Yoshinobu describes a system that determines that a channel at a certain time is a "frequent reception program" if it is viewed more often than a predetermined amount. [Yoshinobu, 2:49-56; 14:48-57.] Thus, Yoshinobu teaches placing certain programs into a single group—the "frequent reception program" group. Within the group, programs are not ranked. When a frequently-viewed program is being broadcast, and when no other program is being watched, the frequently viewed program will be automatically recorded. [Yoshinobu, 24:51-59.]

However, because there is only one variable used to determine if a program will be automatically recorded, the "predetermined amount," a viewer needs a way to signal to the Yoshinobu system when he or she wishes to have a program automatically recorded that has not been previously viewed. This is done by the user assigning a higher weight to certain channels or types of programs. Then, when a program on a weighted channel is viewed, the specific viewing will be given a greater weight; i.e., that specific viewing will count more towards that program reaching the predetermined amount necessary for the program to be considered a "frequent reception" program and therefore automatically recorded. [Yoshinobu, 14:66-15:6.] Determining that certain programs are to be automatically recorded, and allowing the user to bend the rules for certain programs to allow them easier entry into the "frequent reception" category does not rank the viewed broadcast programs, in that the programs are instead divided into two groups; i.e., "do not record" and "automatically record." As Yoshinobu does not provide a ranking of video programs, Yoshinobu does not teach or suggest monitoring the user's viewing habits to *determine a ranking* of viewed broadcast video programs by viewing frequency.

In fact, as Yoshinobu provides a single value, the “predetermined amount,” which determines if a program will be automatically recorded, this teaches away from *ranking* viewed programs by viewing frequency, as a single value cannot provide a ranking .

It is true that Yoshinobu does allow a user’s preset recording reservation to override an automatic “frequent reception” recording. [Yoshinobu, 11:38-43.] However, a user override of an automatic program recordation does not teach or suggest “*monitoring* the user’s viewing habits,” as there is no monitoring done, rather the user controls when the override occurs. Thus, as Yoshinobu fails to teach or *suggest monitoring the user’s viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency*, Applicants respectfully submit that claims 7 and 14 are in condition for allowance.

As Yoshinobu teaches away from ranking, Yoshinobu also fails to teach or suggest *copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking*. As stated above, Yoshinobu does allow a user’s preset recording reservation to override an automatic “frequent reception” recording. [Yoshinobu, 11:38-43.] However, such a user override has nothing to with any ranking of the programs, rather, the user makes a determination to copy a specific program with no hint in Yoshinobu that such a choice is based on a ranking. Therefore, claims 7 and 14, for this further reason, are in condition for allowance.

#### *Claims 15-18.*

Additionally, claims 15-18 ultimately depend from allowable claim 14. In the interest of brevity, Applicants do not belabor the language of each of the dependent claims, but point out that they recite novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander-Lazarus combination. Further, since they depend from allowable claim 14, they should be allowed for at least the reasons stated for claim 14. Claims 15-18 should be allowable. Such action is respectfully requested.

#### ***Claims Rejected Over a Proposed Herz-Yoshinobu-Alexander-Lazarus-Daniels Combination***

The Office asserts a rejection of claim 19 as obvious over Herz, Yoshinobu, and Alexander, in view of Lazarus, and further in view of Daniels, U.S. Patent Publication No. 2002/0032907 (“Daniels”).



*Claim 19.*

Applicants respectfully assert that claim 19 recites novel and nonobvious features allowable over the proposed Herz-Yoshinobu-Alexander-Lazarus-Daniels combination. Further, since it depends from allowable claim 14, it should be allowed for at least the reasons stated for claim 14. Claim 19 should be allowable. Such action is respectfully requested.

**New Claims**

Support for the new claims 22-26 is found throughout the specification and figures as originally filed. Specifically, support can be found at, e.g., page 6, lines 19-22.

**Conclusion**

The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 595-5300  
Facsimile: (503) 595-5301

By /Genie Lyons/  
Genie Lyons  
Registration No. 43,841